

Applicants: Peter S. Linsley et al.
U.S. Serial No.: 09/454,651
Filed: December 6, 1999
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REMARKS

In paragraph 1 of the Office Action

Claims 38, 40, 43-45 are being examined.

In paragraph 2 of the Office Action

Rejections of record can be found in the previous Office Action.

In paragraph 3 of the Office Action

The Patent Office indicates that the Drawings are unacceptable because the formal drawings of Figures 17-21, previously submitted on September 24, 2002, are on A4 paper but all other figures are on 8 ½ x 11 inch paper. The Office is requiring that Applicants submit drawings on the same size paper.

In response, Applicants provide formal drawings of Figures 17A, 17B and 18-21 on 8 ½ x 11 inch paper (attached herewith as Exhibit 1). Applicants respectfully request entry of the drawings attached herein.

In paragraph 4 of the Office Action

The Patent Office is requesting Applicants to verify the inventorship of the instant application given that the inventorship of the priority documents appears to differ from the inventorship currently indicated.

At the outset, Applicants maintain that the inventors of the currently claimed subject matter are: Linsley, Ledbetter, Damle and Brady.

The subject application was filed as a continuation application of the parent case, U.S. Serial No. 08/228,208, now U.S. Patent No. 6,090,914. According to Patent Office practice, the inventors initially named in the parent application are retained for the subject continuation application unless a petition to correct inventorship is filed in the later filed subject continuation application (MPEP §201.03). In the parent case, the inventors named in a first executed Declaration were: Linsley, Ledbetter, Damle, Brady and Wallace. Until September 24, 2002, no such petition was filed. Although, as discussed below, a **copy** of the March 27, 1998, Petition to Correct Inventorship filed in connection with the parent application (U.S. Serial No. 08/228,208) was submitted in the subject application, this Petition cannot change inventorship in the subject application because the Petition relates to a different case (MPEP §201.03). Therefore, the named inventors for the subject application (barring a decision on the petition of September 24, 2002) are: Linsley, Ledbetter, Damle, Brady and Wallace.

In the parent case, U.S. Serial No. 08/228,208, changes to the claims necessitated a correction of inventorship to remove Damle and Wallace, and add Peach and Bajorath. Accordingly, on March 27, 1998, in the parent case, Applicants submitted a Petition to Correct Inventorship Under 37 C.F.R. §1.48(b) and (c), and a newly executed second Declaration. The Patent Office granted the petition. U.S. Serial No. 08/228,208 (now the '914 patent) issued with named inventors: Linsley, Ledbetter, Peach, Brady and Bajorath.

As originally filed in the subject application (which was filed during the pendency of the parent case, U.S. Serial No. 08/228,208) applicants submitted **copies** of (1) the application of the parent case, (2) the first and second Declarations under Rule 63, and (3) the March 27, 1998 Petition to Correct Inventorship, all of which were previously

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submitted in the parent, but only to show a change of inventorship had occurred in the parent case (now '914 patent).

With regard to the subject application, claim changes necessitated correction of inventorship. The inventors for claims 38, 40 and 43-45 are: Linsley, Ledbetter, Damle and Brady. Accordingly, on September 24, 2002, Applicants submitted a Petition to Correct Inventorship Under 37 C.F.R. §1.48(b) to remove Wallace as an inventor, thus leaving as inventors, Drs. Linsley, Ledbetter, Damle, and Brady. This Petition is an original petition and was filed in connection with this case. Applicants are still awaiting the results of this petition.

Applicants wish to point out that the Patent Office alleges that a Petition to Correct Inventorship Under 37 C.F.R. §1.48(b) and (c) was filed on (or around) June 18, 2000. This may be in error. Applicants' records show no such petition with this date.

In paragraphs 5 and 6 of the Office Action

The Office rejected claims 38, 40, and 43-45 under 35 U.S.C. §102(e) as allegedly anticipated by Linsley et al. (U.S. Patent No. 5,580,756) for the reasons of record set forth in the previous-Office Action (Paper Nos. 13, 18, and 22).

The inventors of the claimed invention are Drs. Peter Linsley, Jeffrey Ledbetter, Nitin Damle, and William Brady. The inventors of the claimed invention and the claims of the '756 patent are the same; hence, the invention was not described in a patent by another as required under 35 U.S.C. §102(e). Accordingly, the 35 U.S.C. §102(e) rejection is moot.

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In paragraph 7 of the Office Action

The Office rejected claims 38, 40, and 43-45 under 35 U.S.C. §102(f) because allegedly applicants did not invent the claimed subject matter.

Once again, the inventors of the claimed invention are Drs. Peter Linsley, Jeffrey Ledbetter, Nitin Damle, and William Brady for the reasons set forth in Applicants' response to paragraph 4 of the Office Action and applicants' petition dated September 24, 2002. Accordingly, this rejection should be withdrawn.

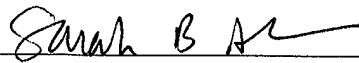
CONCLUSION

Applicants believe that all grounds for rejection of the claims have been successfully overcome and that the claims are now in condition for allowance. Withdrawal of the Examiner's remaining rejections is requested and prompt allowance of the claims is solicited. If any issues remain in connection with the claims, the Examiner is encouraged to contact the undersigned by telephone to discuss the same.

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No fee, other than the \$410.00 fee for extension of time, is deemed necessary in connection with the filing of this response. If any fee is deemed necessary, the Patent Office is authorized to charge the amount of any such fee to Deposit Account No. 50-0306.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Sarah B. Adriano", is written over a horizontal line.

Sarah B. Adriano
Registration No. 34,470
SaraLynn Mandel
Registration No. 31,853
Attorneys for Applicants
Mandel & Adriano
55 South Lake Ave., #710
Pasadena, California 91101
Tel: (626) 395-7801
Customer Number: 26941